

### **REMARKS/ARGUMENTS**

Claims 41-60 were examined with Claims 47-58 standing withdrawn from consideration following the response to the Restriction Requirement mailed on October 5, 2004. With this amendment, Claims 47-58 are canceled without prejudice to prosecution of their subject matter in divisional, continuation, or continuation-in-part applications. New Claims 61-64 are added with this amendment. Accordingly, Claims 41-46 and 59-64 are pending in the application.

The amendments to the specification state the relationship between the cited copending parent applications and the present application. No new matter is added by way of the amendments to the specification.

The amendments to the claims find support, for example, at page 3, lines 17-20 and 36-38, page 4, lines 23-24, page 8, lines 5-29, in the sequence listings, and elsewhere in the specification and claims as originally filed. Support for the new claims may be found, for example, in the specification and claims as originally filed, including, for example, in the specification at page 3, lines 17-20 and 36-38, page 4, lines 23-24, page 8, lines 5-29, in the sequence listings, and elsewhere in the specification and claims. No new matter is added by way of the claim amendments or by way of the new claims.

The oath stands objected to as allegedly being defective in that one of the inventors neglected to date his signature and to initial corrections made to his address.

The specification stands objected to as not properly identifying the relationship between the present application and related co-pending applications to which priority is claimed.

The information disclosure statement filed on April 2, 2002 is objected to with regard to a single reference crossed out by the Examiner.

Claims 43 and 46 stand objected to under 37 C.F.R. §1.75(c) as allegedly being of improper dependent form.

Claim 43 stands rejected under 35 U.S.C. §101 for double patenting as allegedly claiming the same invention as that of Claim 1 of prior U.S. Patent No. 6,504,007.

Claims 41-42, 44-46 and 59-60 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 2 of U.S. Patent No. 6,504,007.

Applicants respectfully traverse these objections and rejections.

**The Oath**

The oath stands objected to as allegedly being defective in that one of the inventors neglected to date his signature and to initial corrections made to his address.

A signed and dated oath listing the correct home address of the inventor accompanies this amendment. Accordingly, applicants believe the objection to the oath to be overcome.

**The Priority Claim**

The specification stands objected to as not properly identifying the relationship between the present application and related co-pending applications to which priority is claimed.

As amended, the specification makes specific reference to the related copending applications and states the relationship between the present application and the related copending applications. Accordingly, applicants believe that the objections to the specification are overcome.

**Correspondence Address**

The Office Action mailed on February 23, 2005 was erroneously addressed to Genentech, Inc., at 1 DNA Way, South San Francisco, CA 94080. According to the Revocation and Power of Attorney and Change of Address form, which was filed with the U.S. Patent and Trademark Office on April 8, 2003, the correct address for all communications is:

CUSTOMER NO. 25213  
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**The Information Disclosure Statement**

The information disclosure statement filed on April 2, 2002 is objected to with regard to a single reference crossed out by the Examiner.

The Information Disclosure Statement (IDS) filed April 2, 2002 listed WO97/33912 as a reference. Applicants submit an IDS and provide a substitute copy of reference WO97/33912 with the present amendment. Accordingly, a legible copy of the cited foreign patent document being provided, applicants believe that the objections to the IDS are overcome.

**The Objections to Claims 43 and 46 Under 37 C.F.R. §1.75(c)**

Claims 43 and 46 stand objected to under 37 C.F.R. §1.75(c) as allegedly being of improper dependent form, the Examiner alleging that these claims fail to further limit the subject matter of the previous claim, so as to improperly broaden the base claims. The Examiner noted that the base Claims 41 and 44 are directed to amino acid sequences having at least 95% (Claim 41) or 99% (Claim 44) sequence identity with the sequence as set out between amino acids Asp25 and Ser468 of SEQ ID NO:2, while Claims 43 and 46 recite "sequence as set out between amino acids Asp25 and Gly427 of SEQ ID NO:2."

As amended, Claims 43 and 46 now recite "sequence as set out between amino acids Asp25 and Ser468 of SEQ ID NO:2" (emphasis added). Accordingly, applicants believe that Claims 43 and 46 further limit the claims from which they depend, and that the objections to Claims 43 and 46 are overcome.

**The Rejection of Claim 43 Under 35 U.S.C. §101**

Claim 43 stands rejected under 35 U.S.C. §101 for double patenting as allegedly claiming the same invention as that of Claim 1 of prior U.S. Patent No. 6,504,007.

Claim 1 of prior U.S. Patent 6,504,007 is:

1. An isolated polypeptide comprising a GDNFR $\alpha$  extracellular domain having the amino acid sequence as set out between amino acids Asp25 and Gly427 of SEQ ID NO:2

However, as amended, present claim 43 is directed to:

43. The isolated polypeptide of claim 41 comprising the GDNFR $\alpha$  extracellular domain sequence as set out between amino acids Asp25 and Ser468 of SEQ ID NO: 2.

Present Claim 43 recites a different amino acid sequence (the sequence between Asp25 and Ser468 of SEQ ID NO: 2) than does Claim 1 of U.S. Patent 6,504,007 (which recites the sequence between Asp25 and Gly427 of SEQ ID NO: 2). Thus, the claims are not coextensive in

scope, since the two claims are directed to different subject matter. Accordingly, Applicants submit that the double patenting rejection of Claim 43 under 35 U.S.C. §101 for allegedly claiming the same invention as that of Claim 1 of prior U.S. Patent No. 6,504,007 is overcome.

#### **The Rejections of Claims 41-42, 44-46 and 59-60**

Claims 41-42, 44-46 and 59-60 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly not being patentably distinct from Claim 2 of prior U.S. Patent 6,504,007. In support of these rejections, the Examiner notes that Claim 2 of prior U.S. Patent No. 6,504,007 has "'at least 95/99% identity...' to that now recited in instant Claims 41 and 42, thereby making compositions of such also obvious." In support of these rejections, the Examiner further suggests that "fusion of immunoglobulin heavy chain constant domain sequences to make chimeric proteins/immunoadhesins that have increased half life are well known in the art." The Examiner goes on to suggest that it would thus have been obvious to one of ordinary skill in the art at the time of filing the Applicant's invention to make chimeric polypeptides of the GDNFR polypeptides claimed in U.S. Patent 6,504,007 with immunoglobulin heavy chain constant domain sequences.

Applicants submit that the present claims are not obvious over Claim 2 of U.S. Patent No. 6,504,007. However, without acquiescing in these rejections, Applicants hereby include a Terminal Disclaimer over U.S. Patent No. 6,504,007, so that a U.S. Patent issued from the present application will have a patent term no longer than the full patent term of U.S. Patent No. 6,504,007.

#### **CONCLUSION**

For the reasons set forth above, Applicants believe that all objections and rejections are overcome, and that the claims are in condition for allowance. Thus, the present application is believed to be in *prima facie* condition for allowance. The Examiner is respectfully requested to reconsider the objections and rejections, and to allow all pending claims. Should the Examiner believe that a telephone interview would expedite the prosecution of this application, Applicants invite the Examiner to call the undersigned attorney at the telephone number indicated below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39766-0048 CP1C1.

Respectfully submitted,

Date: April 25, 2005

By: 

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